

REMARKS

In accordance with the foregoing, claims 1, 2, 4 and 5 are herein amended. In a prior transmittal, claims 6-12 were withdrawn from consideration. Claims 1-5 are pending and under consideration.

In the January 30, 2006 Office Action, claims 1-5 were rejected under 35 USC § 112, second paragraph as indefinite. Also, claims 1-5 were rejected under 35 USC § 103 as obvious. Finally, in the Office Action Summary, acknowledgment was NOT made of the claim for foreign priority. It is respectfully requested that Applicant's claim for foreign priority under 35 § 119 be acknowledged in the next Office Action. The rejections are respectfully traversed below.

Rejections under 35 USC § 112

In item 3 on page 2 of the January 30, 2006 Office Action, claims 1-5 were rejected under 35 USC § 112, second paragraph as indefinite because it "is not clear as to how the 'customer' ... is related to 'holder of securities'" (Office Action, page 2, lines 15-16). Claims 1, 4 and 5 are herein amended to clarify that the customer who purchases the securities is the real stockholder of the securities after the customer has purchased the securities in a securities trading transaction as described in the specification at least at page 10, lines 18-27; page 11, lines 1-2; and page 7, lines 1-2. Dependent claims 2 and 3 are not indefinite for the same reasons as discussed in regard to claim 1. It is respectfully requested that the rejections of claims 1-5 under 35 USC § 112 be withdrawn.

Rejections under 35 USC § 103

In item 5 spanning pages 3-6 of the Office Action, claims 1-5 were rejected under 35 USC § 103(a) as unpatentable over Quinlan (US 6,748,365) in view of Hawkins (US 6,247,000).

Claim 1 recites "storing customer information in a securities company server that manages customers of a securities company, the customer information including a name and a postal address of each customer of the securities company" (Claim 1, lines 3-5).

It was admitted in the Office Action that "Quinlan does not explicitly teach ... wherein the product is a security" (Office Action, page 3, line 16).

What was cited in Quinlan describes a point-of-sale retail sales system where a "fulfillment administrator has on file a stored data record comprising personal information about each consumer indexed by the designated card number, so the fulfillment administrator then associates the transaction data record with the corresponding stored data record for the designated card number" to facilitate a "cash value of the rebate claims ... [being] credited to the

consumer" (column 6, lines 1-9). In other words, what was cited in Quinlan has nothing to do with "storing in a securities company server that manages customers of a securities company ... a name and postal address of each customer of the securities company" as recited in claim 1. In contrast to financial securities company limitations, recited in claim 1, Quinlan discloses nonanalogous art directed to rebates relating to retail sales in a point of sales system. Furthermore, according to Quinlan, a customer's personal information is stored in a third party fulfillment house storage unit not the securities company server as recited in claim 1.

Claim 1 recites "identifying as the holder of the securities the customer who has purchased the securities by consulting the transaction information and the customer information" (Claim 1, lines 8-9). What was cited in Quinlan describes a point-of-sale retail sales system where a "fulfillment administrator receives in the electronic file transfer from the POS system at least one transaction data record comprising the designated card number and the corresponding transaction serial number for the qualified transaction" (column 5, lines 64-67 to column 6, lines 1) to enable a "cash value of the rebate claims ... [being] credited to the consumer" (column 6, lines 1-9). In other words, what was cited in Quinlan has nothing to do with "identifying as the holder of the securities the customer who has purchased the securities by consulting the transaction information and the customer information" as recited in claim 1. As discussed above, it was admitted in the Office Action that "Quinlan does not explicitly teach ... wherein the product is a security" (Office Action, page 3, line 16). Thus, in contrast to identifying the real stockholder of financial securities a customer purchased "by consulting the transaction information and the customer information as recited in claim 1, Quinlan discloses nonanalogous art directed to receiving transaction information associated with rebates relating to retail sales in a point of sales system. Furthermore, in the Office Action, a point-of-sale retailer is equated with a financial securities broker.

Claim 1 recites "storing information about the name and postal address of the identified customer in the securities company server" (Claim 1, lines 10-11). As discussed above, it was admitted in the Office Action that "Quinlan does not explicitly teach ... wherein the product is a security" (Office Action, page 3, line 16). Next, it was alleged in the Office Action that Hawkins teaches "wherein the product is a security (See Hawkins Column 21 line 66 – Column 24 line 35)" (Office Action, page 3, lines 17-18). Notwithstanding the disclosure of Hawkins of "[confirmation of] ... securities settlement instructions" (Column 22, line 1), nothing was cited or found in Quinlan and Hawkins either combined together or taken individually that teaches or suggests "name and postal address of the identified customer in the securities company server" recited in claim 1.

Claim 1 recites "making the stored information about the name and postal address of the identified customer accessible to a public company that originally issued the securities purchased by the identified customer" (Claim 1, lines 12-14). As discussed above, it was admitted in the Office Action that "Quinlan does not explicitly teach ... wherein the product is a security" (Office Action, page 3, line 16). Next, it was alleged in the Office Action that Hawkins teaches "wherein the product is a security (See Hawkins Column 21 line 66 – Column 24 line 35)" (Office Action, page 3, lines 17-18). Notwithstanding the disclosure of Hawkins of "[confirmation of] ... securities settlement instructions" (Column 22, line 1), nothing was cited or found in Quinlan and Hawkins either combined together or taken individually that teaches or suggests "making the stored information about the name and postal address of the identified customer accessible to a public company that originally issued the securities purchased by the identified customer" recited in claim 1. Also, according to the present invention, the securities company server makes the name and postal address of a stockholder accessible to the public company that originally issued the securities. This feature of claim 1 is not taught by card transactions described in Quinlan. The Office Action failed to establish a case of *prima facie* obviousness because nothing was cited or found in Quinlan and Hawkins either combined together or taken individually that teaches or suggests each limitation of claim 1. Furthermore, nothing was cited or found in Quinlan and Hawkins either combined together or taken individually that teaches or suggests motivation to modify Quinlan or combine Hawkins with Quinlan to derive the limitations missing from the primary reference to Quinlan.

Independent claim 4 recites "securities company server" limitations, securities transaction limitations "information about the name and postal address of the identified customer in the securities company" limitations and securities "public company" limitations in a manner similar to claim 1. Dependent claim 2 and 3 depend from claim 1. Thus, claims 2-4 distinguish over the applied art for the reasons discussed above in regard to the traversal of the rejection of claim 1.

In addition, on page 4 of the Office Action, Official Notice was taken that dependent claims 2 and 3 are obvious because each limitation recited in claims 2 and 3 are well known in the art of "Corporate Finance" and in order to receive benefits given to holders claim 2 and claim 3 respectively. The Applicants respectfully traverses the Examiner's statements invoking Official Notice evidence and demands the Examiner produce authority for the statements. The Applicants specifically points out the following errors in the Examiner's action: The noticed facts are not of notorious character or capable of instant and unquestionable demonstration as being well known. Instead, the limitations of claims 2 and 3 are unique to the present invention. See

MPEP § 2144.03(A) ("the notice of facts beyond the record which may be taken by the Examiner must be "capable of such instant and unquestionable demonstration as to defy dispute"). Also, there is no evidence supporting the Examiner's assertion. See MPEP § 2144.03(B) ("there must be some form of evidence in the record to support an assertion of common knowledge").

Finally, it appears that the Examiner also bases the rejections of claims 2 and 3, at least in part, on personal knowledge. The Examiner is required under 37 CFR § 1.104(d)(2) to support such an assertion with an affidavit when called for by the Applicants. Thus, Applicants call upon the Examiner to support such assertion with an affidavit. For these additional reasons, claims 2 and 3 distinguish over the applied art and Official Notice evidence and are in condition for allowance.

Independent claim 5 recites "identifying a holder of securities as a customer who has purchased the securities ... by comparing the transaction information with the customer information" limitations in a manner similar to claim 1. Thus, claim 5 distinguishes over the applied art for reasons discussed above in regard to the traversal of the rejection of claim 1.

CONCLUSION

It is submitted that the references cited by the Examiner either combined together or taken individually do not teach or suggest the features of the claimed invention. Thus, it is submitted that claims 1-5 are in condition suitable for allowance. Entry of the Amendment, reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Finally, if there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8(a)
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 30, 2006
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